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**PATENT**

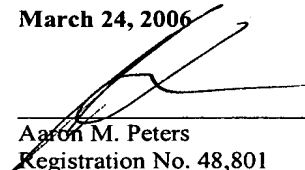
**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant : BEAULIEU, Nicole )  
Ser. No. : 10/073,598 )  
Filed : February 11, 2002 )  
Title : Automated Selection of Video )  
Gaming Options )  
Art Unit : 3714 )  
Examiner : Mosser, Robert E. )

I hereby certify that this paper is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to:

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March 24, 2006

  
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**REPLY BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed January 24, 2006 in connection with the above-identified patent application, Applicant respectfully submits the instant Reply Brief in accordance with 37 C.F.R. §41.41.

**REMARKS**

The plain language of the claims makes clear that data related to a request from a person is received and an automated selection is made in response to the request from the person. The Examiner's Answer applies an erroneous claim construction contrary to the plain language of the claims. Further, the Examiner's Answer attempts to significantly broaden the plain teachings of the Bennett reference and attempts to inject new rationale significantly broader than that provided in the final Office action.

### **The Claim Construction is Contrary to the Plain Language of the Claims**

The appropriate beginning for any determination of patentability is the plain language of the claims, an examination of which provides a straightforward basis for reversing the claim rejections. Claim 1 provides an example of the language at issue:

said controller being programmed to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to make an automated selection from among a plurality of user-selectable options presented to said person,

said controller being programmed to make an automated selection from among said plurality of user-selectable options in response to said request,

The Examiner's Answer applies an erroneous claim construction contrary to the plain language of the claims. For example, the Examiner's Answer asserts that Applicant contends the claim language "is equivalent to the positive selection by a person through a specific structural element." *See* Examiner's Answer pages 8-9. To the contrary, Applicant's arguments have been limited solely to the plain language of the claims, with the exception of addressing the Examiner's assertion that action is equivalent to inaction. Indeed, an analysis of the plain language of the claims is all that is necessary to demonstrate the failings of both the final Office action and the Examiner's Answer.

The Examiner's Answer attempts to unreasonably broaden the scope of the claims by ignoring the plain language of the claims. In particular, the Examiner's Answer does not appreciate the language of the claims in that the Examiner's Answer construes the claims as receiving data from any source because the claim language does not recite the source, manner or method by which the request is derived. *See* Examiner's Answer page 9. However, the plain language of the claims specifically demonstrates that the data relates to a request from a person, and the controller is responsive to the request from the person. Logically, in order to receive data relating to a request from a person, the person must provide an indication of such a request, such as an input. For example, page 15, line 30 to page 16, line 1 and page 17, lines 21-23 clearly demonstrate an example of receiving data relating to a request from a player where a player provides an input by actuating an automated selection button or

graphic.<sup>1</sup> When giving the claims their broadest reasonable interpretation consistent with the specification, only when the person provides the request does the controller make an automated selection.<sup>2</sup> As a result, the claim language specifically recites data relating to a request from a person. The controller is not responsive to a request from just any source such as the controller itself.

The Examiner's Answer attempts to justify the misconstruction of the claims by stating that the relevant claim elements are merely functional elements. *See* Examiner's Answer page 9. It is respectfully submitted that, while it is permissible for the Examiner to give claim recitations their broadest reasonable interpretation in construing a claim, it is not proper to completely ignore entire phrases of a claim. Furthermore, even if recitations of the claims are considered to be "functional elements," such recitations must be considered. *See, for example, Ex parte Bylund*, 217 U.S.P.Q. 492, 498 (PTO Bd. of App. 1981), where the Patent Office Board of Appeals stated: "Although we have sustained several of the Examiner's rejections we here wish to specifically note that contrary to the Examiner's assertions, functional language in the claims must be given full weight and may not be disregarded in evaluating the patentability of the subject matter defined employing such functional language." (emphasis added). It is improper to simply ignore the plain recitations in a claim, under the guise of applying the broadest reasonable interpretation.

### **The Application of Bennett is Contrary to the Plain Teachings of Bennett**

The language of Bennett relied upon in the final Office action and in the Examiner's Answer reads as follows:

"In the embodiment of FIG. 2, the selection would default to the centre line position in the event that no symbol was selected in a particular column."

As a result of the improper claim construction, the Applicant was left to conclude that the final Office action relied upon an erroneous standard for determining anticipation (i.e.,

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<sup>1</sup> *See also* application page 10, lines 9-12; page 18, lines 28-30; page 21, lines 3-5 and 13-15; page 22, lines 38-30; page 23, lines 21-23; page 25, lines 3-6 and 15-17; page 26, lines 3-5 and 15-17; page 27, lines 9-15; and in Figs. 2A and 6-18).

<sup>2</sup> *See* M.P.E.P. §2111 "During patent examination, the pending claims must be 'given \*>their< broadest reasonable interpretation consistent with the specification.' >In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).<"

equivalency of function).<sup>3</sup> However, when applying the correct claim construction provided above, the straightforward standard for a claim to be anticipated under 35 U.S.C. § 102 requires that the anticipating reference disclose at least one embodiment that incorporates all of the claimed elements.<sup>4</sup> As with the final Office action, the Examiner's Answer fails to specifically address where Bennett discloses receiving data relating to a request from a person for a controller to automatically select a user-selectable option. Instead, the Examiner's Answer essentially maintains that action is equivalent to inaction, and receiving data relating to a request from a person is equivalent to receiving data relating to a request from any source. It cannot be emphasized too strongly that "inaction" is the very antithesis of "action." By citing the antithesis of action, the Examiner's Answer does not meet the standard for anticipation. Further, receiving data relating to a request from a person is entirely distinct from receiving data relating to a request from any source.

The Examiner's Answer attempts to explain the teachings of Bennett by analogy. See Examiner's Answer pages 10-11. However, the analogy is merely an attempt to unduly broaden the plain teachings of Bennett. In summary, the analogy is a post-hoc justification that attempts to explain the perception of the controller of Bennett, yet the language of Bennett relied upon in the final Office action and in the Examiner's Answer merely states that "the selection would default to the centre line position in the event that no symbol was selected."

The cited portion of Bennett provides absolutely no indication of the perception of the controller, and only teaches that the selection would default to the center line position in the event that no symbol was selected. Bennett is otherwise silent on what, if any, data is received by the controller. Consequently, the analogy provided in the Examiner's Answer is based on mere conjecture that is wholly unsupported by the teachings of Bennett. The analogy of the Examiner's Answer cannot take the place of the plain teaching of the reference. As such, this excerpt of Bennett still does not disclose the claimed features as

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<sup>3</sup> Specifically, page 7 of the final Office action reads "[t]he heart of the issue is the fact that both systems provide an automated selection based on the action (and equivalent lack of action) by the user, hence providing equivalent function as so claimed." Logically, Applicant was left to conclude that the final Office action relies upon an erroneous "equivalency of function" standard for determining anticipation.

<sup>4</sup> See e.g., C.R. Bard, Inc. v. M3 Systems, 48 U.S.P.Q.2d 1225, 1230 (Fed. Cir. 1998) ("When the defense of lack of novelty is based on a printed publication that is asserted to describe the same invention, a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device")(emphasis added); In re Bond, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990) ("For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference... These elements must be arranged as in the claim under review...")(emphasis added).

noted above because the selection is not made in response to a request from a person as recited in the claims.

### **The Examiner's Answer Attempts to Inject New Rationale**

In addition, the Examiner's Answer attempts to introduce additional rationale for the claim rejections which was never provided in any of the previous Office actions. In particular, the Examiner's Answer introduces an analogy that attempts to explain the perception of the controller of Bennett in the absence of an action by a player. Applicant respectfully submits that if the goal of prosecution is to sharpen the issues for appeal, then the issues were not sharpened for appeal in the present case. Simply put, if the final Office action alone cannot provide a sufficient rationale for rejecting the claims, then the rejections inherently fail to meet the *prima facie* requirements of anticipation. For these reasons, the extraneous analogy provided in the Examiner's answer should be ignored.

### **CONCLUSION**

For the foregoing reasons, it is respectfully submitted that a *prima facie* case of anticipation or obviousness of the claims on appeal has not been made. Appellant therefore requests that the rejection of the claims be reversed.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 13-2855, under Order No. 29757/P-576.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

March 24, 2006

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